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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941.

NO. 991

EDWIN L. WIEGAND COMPANY AND
EDWIN L. WIEGAND,
Petitioners,

VS.

HAROLD E. TRENT COMPANY AND
HAROLD E. TRENT,
Respondents.

PETITION FOR WRIT OF CERTIORARI

TO THE UNITED STATES CIRCUIT COURT OF APPEALS
FOR THE THIRD CIRCUIT

AND BRIEF IN SUPPORT THEREOF

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Respondents.

PETITION FOR WRIT OF CERTIORARI

To the Honorable the Chief Justice and the Associate Justices of the Supreme Court of the United States:

Your petitioners, Edwin L. Wiegand Company and Edwin L. Wiegand, pray that a writ of certiorari issue to the United States Circuit Court of Appeals for the Third Circuit, to review the judgment of that Court entered June 30, 1941.

SUMMARY STATEMENT

The action is a suit by petitioners against respondents, in the District Court of the United States for the Eastern District of Pennsylvania, for patent infringement, copyright infringement, and unfair competition. (R. 1-14.)

This petition is directed only to the cause for infringement of claims 1, 3, 5, 8, 9, and 12, of Letters Patent 1,614,-330, for an electrical heating element, granted to petitioner Edwin L. Wiegand on January 14, 1927. (R. 2-3.) Peti-

tioner Edwin L. Wiegand Company was and is the exclusive licensee. (Exhibit W-17, R. 187, offered at R. 69-70.)

The District Court held the claims infringed if valid, but invalid. (R. 24-29 and 52-53.) The Circuit Court of Appeals held the claims invalid (R. 62-63, omitting the footnotes):

> The invention alleged is for the envelopment and insulation of a wire resistor by a cement-like or porcelain refractory medium. In the earlier heaters, the insulating material is mica. The patent (French) to Luftfahrzeugbau discloses a heating unit "bedded in electrically insulating material." Two patents (British and Swiss) to Muller disclose "a resistance wire wound on a heat-proof insulating plate." The only escape from anticipation must therefore lie in the substitution of the precise material. We are in accord with the learned district judge in his view that the use of such material for analogous purposes was extensive and well-known.

The Circuit Court of Appeals did not pass on the holding of infringement. Petition for rehearing was denied. (R. 68.)

This petition is directed solely to the issue of validity of said claims 1, 3, 5, 8, 9, and 12, of said patent 1,614,330.

JURISDICTION

The jurisdiction of this Court is invoked under Judicial Code, section 240 (a) as amended. (U. S. C., Title 28, section 347 (a) as amended.)

In the matter of this petition, the action is a suit under the patent laws of the United States, under Judicial Code, section 24, sub-section 7. (U. S. C., Title 28, section 41, subsection 7.)

The judgment which petitioners seek to have reviewed, was entered June 30, 1941. Petition for rehearing was denied October 30, 1941. The time within which to file this petition has been extended to and including March 3, 1942.

QUESTIONS PRESENTED

1. Whether claims 1, 3, 5, 8, 9, and 12, of patent 1,614,330, were properly held invalid, particularly for want of invention in view of the Luftfahrzeugbau French patent 517,311, the Muller Swiss patent 83,457, and the Muller British "patent" 140,738. (An application as laid open to inspection, on which patent was not granted, R. 150.)

2. Whether it is proper to construe a patent to be for a different combination and of materially wider scope than defined by the claims, and if so, whether then it is proper to hold the claims invalid for want of invention in the subject matter as construed.

3. Whether it is proper to defeat an invention on inference of disclosure in a foreign patent, particularly when there is no presumption that the foreign patent disclosed anything new or novel whatsoever.

4. Whether it is proper to hold that an improvement did not involve invention, when the deficiencies of the prior devices had long been recognized, and those skilled in the art had long been working to discover a solution, and had not succeeded.

REASONS FOR GRANTING THE WRIT

1. The holding of invalidity is in conflict with the prevailing recognition of the invention and the judgment of a court of another circuit.

2. The holding of invalidity is predicated on an interpretation of the invention in conflict with applicable decisions of this Court.

3. The holding of invalidity is predicated on assumptions of disclosure by the three foreign patents in conflict with applicable decisions of this Court.

4. The holding of invalidity is in conflict with applicable decisions of this Court that an improvement that was not obvious to those skilled in the art is invention.

5. Because of the general recognition of the patent, any basis for another suit is not likely to occur.

PRAYER

Petitioners pray that a writ of certiorari issue to the United States Circuit Court of Appeals for the Third Circuit, to the end that this cause may be reviewed and determined by this Court, and that the judgment of said Circuit Court of Appeals be reversed, and that petitioners be granted such other and further relief as may be proper.

HADLEY F. FREEMAN,
Counsel for Petitioners.

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Respondents.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

OPINIONS IN THE COURTS BELOW

The original opinion of the District Court is reported at 39 USPQ 158, and appears at R. 23-32.

The opinion of the District Court on rehearing is reported at 43 USPQ 149, and appears at R. 48-56.

The opinion of the Circuit Court of Appeals is reported at 122 F. (2d) 920 and 50 USPQ 243, and appears at R. 60-68.

GROUNDS OF JURISDICTION

Stated in the Petition.

STATEMENT OF THE CASE

Stated in the Petition.

SPECIFICATION OF ERRORS

Petitioners believe that the Circuit Court of Appeals erred:

1. In holding that the invention alleged is for the envelopment and insulation of a wire resistor by a cement-like or porcelain refractory material.

2. In construing the Luftfahrzeugbau French patent 517,311, the Muller Swiss patent 83,457, and the Muller British patent 140,738, as disclosing the invention except only for the substitution of the precise material.

3. In holding that the only escape from anticipation must lie in the substitution of the precise material.

4. In not holding that the improvement was not obvious to those skilled in the art, and involved invention.

5. In holding the claims in suit invalid, particularly for want of invention over the three foreign patents.

6. In not holding the claims in suit valid.

SUMMARY OF ARGUMENT

1. The holding of invalidity is in conflict with the prevailing recognition of the invention and the judgment of a court of another circuit.

2. The holding of invalidity is predicated on an interpretation of the invention in conflict with applicable decisions of this Court.

3. The holding of invalidity is predicated on assumptions of disclosure by the three foreign patents in conflict with applicable decisions of this Court.

4. The holding of invalidity is in conflict with applicable decisions of this Court that an improvement that was not obvious to those skilled in the art is invention.

ARGUMENT

1. The holding of invalidity is in conflict with the prevailing recognition of the invention and the judgment of a court of another circuit.

The electrical heating elements described and claimed in the patent in suit largely superseded the various types of electrical heating elements theretofore in use. (R. 115.) Also they opened new field for electrical heating elements. (Exhibit M-4, R. 207, offered at R. 131.) They attained and have enjoyed marked commercial success. (R. 72-73.)

They were accorded the tribute of imitation, yet after the grant of the patent the infringers discontinued, on notice of the patent. (R. 173-175.) Manufacturers of prior types of electrical heating elements, requiring the elements of the patent, have purchased from petitioners. (R. 174.) Respondents advised such notices. (Exhibits C-54 and C-64, R. 206A and 206B, offered at R. 131.)

Respondents devised their elements with the intention of avoiding infringement, and challenged validity only after suit had been filed, and from the grant of the patent the validity of any claim of the patent has been challenged in only one other instance, and then under similar circumstances. In 1931 the Cutler-Hammer Company began the manufacture of elements also intended to avoid infringement, and petitioners brought suit, and then the defendants in that suit likewise contested both validity and infringement.

In that suit, in the District Court of the United States for the Northern District of Ohio, the claims were held valid, although the Cutler-Hammer elements were held not to infringe. (Exhibit D-68, R. 225-226, offered at A-94; affirmed on appeal, but without passing on the holding of ~~infringement~~ validity, Exhibit D-69, R. 226-232, offered at A-94; certiorari denied, 308 U. S. 627, 60 S. Ct. 386.)

The present holding of invalidity is in conflict with the recognition of the patent by the industry generally, with the prior recognition by respondents, and with the judgment, *by a court in another circuit,* in the only other instance in which the validity of any claim of the patent has been challenged.

2. The holding of invalidity is predicated on an interpretation of the invention in conflict with applicable decisions of this Court.

The holding of invalidity is predicated on the premise (R. 62, at the outset of the consideration of the validity of this patent 1,614,330):

> The invention alleged is for the envelopment and insulation of a wire resistor by a cement-like or porcelain refractory medium.

Claim 1 of the patent, for example, states the invention as follows (R. 198, and including the limitations by disclaimer, R. 201-202, and italics added):

> 1. As a new article of manufacture, an electrical heating element consisting of a resistor, *a formed sheet metal sheath enveloping said resistor and spaced therefrom,* the sheath surrounding the resistor being relatively thin and wide in cross section and constituting a surface of relatively large area for the transfer of the heat from the element but defining a relatively shallow cavity of relatively small capacity, the resistor being arranged in a formation correspondingly relatively thin and wide in cross section, and a mass of *compacted granular refractory electrical insulating material of high heat conducting quality filling the space between the resistor and the sheath,* at least part of said material being integrated into formation positively spacing the resistor from the sheath, the resistor being provided with ter-

> minals each accessible through an opening in the sheath.

Obviously the interpretation of the invention on which the holding of invalidity is predicated, is quite different from the invention as defined by the claims, yet as stated in *Motion Picture Patents Company v. Universal Film Manufacturing Company et al.*, 243 U. S. 502 at 510, 37 S. Ct. 416 at 418:

> It is to the claims of every patent, therefore, that we must turn when we are seeking to determine what the invention is, * * *.

And as stated in *Fay and others v. Cordesman and others*, 109 U. S. 408 at 420-421, 3 S. Ct. 236 at 244:

> The claims of the patent sued on in this case are claims for combinations. In such a claim, if the patentee specifies any element as entering the combination, * * * the court cannot declare it to be immaterial.

Under the interpretation, it would not be necessary to resort at all to the three foreign patents on which the Circuit Court of Appeals relies, but the invention would be directly anticipated even by such entirely different devices as those shown for example in figures 5 and 6 of the Delany patent 554,910. (R. 236, part of Exhibit 41, offered at R. 90.)

The interpretation of the invention is improper, and the departure of the interpretation is substantial and material.

3. The holding of invalidity is predicated on assumptions of disclosure by the three foreign patents in conflict with applicable decisions of this Court.

The consideration of the patent by the Circuit Court of Appeals continues (R. 62-63, omitting footnotes):

> The patent (French) to Luftfahrzeugbau discloses a heating unit "bedded in electrically insulating material." Two patents (British and Swiss) to Muller disclose "a resistance wire wound on a heat-proof insulating plate." The only escape from anticipation must therefore lie in the substitution of the precise material.

Referring again to claim 1 for example, it requires specifically (R. 198, including the limitations by disclaimer, R. 201-202):

> and a mass of compacted granular refractory electrical insulating material of high heat conducting quality filling the space between the resistor and the sheath, at least part of said material being integrated into formation positively spacing the resistor from the sheath, * * *.

The limitation to *granular refractory material* relates to the admitted substitution of the precise material. However, each of the three foreign patents fails also in other respects.

Any conclusion that the Muller patents disclose any sort of insulating material filling the space between the resistor and the sheath, is entirely unsupported by anything in the patents. (R. 315-324, parts of Exhibit D-42, offered at R. 90-91.) In fact, the evidence is directly to the contrary.

During the course of the rehearing respondents agreed (R. 185):

> that Muller did construct and put on the market devices substantially in the form of the patent drawings, in which the insulating material used was mica, and that Exhibit W-78 is one of such devices, that the instruction sheet offered in evidence, Exhibit W-79, is one of the instruction sheets which

> Muller packed with his devices when they were sold, and that the translation Exhibit W-80 is a correct translation of the sheet Exhibit W-79, * * *.

The evidence went further, but subsequently respondents moved to strike portions of the evidence, and the motion was granted, and while petitioners believe that the motion should have been denied, and have preserved their objection, reference to that phase of the situation at this time is not necessary.

Exhibit W-78 (physical, offered at R. 159) entirely confirms the testimony of petitioner Edwin L. Wiegand (admitted to be an eminent expert in the electrical heating art, R. 92), that the core plate and layers 4 of the Muller patents were mica, and that the element of the Muller patents was of the typical mica construction. (R. 97-98.)

However, in the mica heaters the insulating material does not fill the space between the resistor and the sheath. Even if the mica traverses generally around the edge (as it does not in Muller) it does not fill that space, and can abstract heat from but two line points of a round resistor, or two flat or flattish sides of a flat resistor, and none from the edges, which are not in contact. Further, it is extremely difficult to maintain any degree of contact; after some use, involving expansion and contraction, the contact is only nominal, at points. (R. 117.)

Further, this distinction is not trivial. It is the outstanding reason why the elements of the patent have largely superseded the mica heaters. (R. 119.)

The Luftfahrzeugbau patent likewise is silent as to the insulating material proposed to be employed. (R. 313-314A, part of Exhibit D-42, offered at R. 90-91.) Apparently the device was never on the market. (R. 153.) There is some indication that the patentee proposed to employ clay. (R. 153.) Mr. Wiegand was of the opinion that the patent intended merely another mica heater (R. 98):

> or else the disclosure is entirely inadequate to enable one skilled in the art, as the art was at that time especially, to construct the element, or to have any idea even as to what the element was supposed to be, or how the element was supposed to be produced, or the disclosure carried into effect.

Under the circumstances, *any conclusion that the Luftfahrzeugbau patent discloses any of the requirements of the above quoted portion of the claim, certainly is sheer speculation.*

Further, the fact of the patents is no indication that any of them disclosed anything new or novel. As to Muller, the Swiss Patent Office makes no examination on the merits, the British Patent Office does, and the so-called Muller British patent in fact is an application laid open to inspection, on which patent was not granted. As to Luftfahrzeugbau, the French Patent Office likewise makes no examination on the merits, the German Patent Office does, Luftfahrzeugbau was a German corporation, and there is no corresponding German patent. (R. 149-151.)

However, as was said in *Hanifen v. E. H. Godshalk Co. et al.*, 84 F. 649 at 651 (C. C. A. 3):

> Now, it is a well-settled and familiar doctrine that an invention patented here is not to be defeated by a prior foreign patent unless its descriptions or drawings contain or exhibit a substantial representation of the patented invention in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains, without the necessity of making experiments, to practice the invention.

Citing *William H. Seymour et al. v. David M. Osborne et al.*, 11 Wall. 516 at 555. (20 L. Ed. 33 at 42.)

The conclusion that "The only escape from anticipation must therefore be in the substitution of the precise

material," is predicated on assumptions of disclosure by the foreign patents in conflict with applicable decisions, and fails.

4. The holding of invalidity is in conflict with applicable decisions of this Court that an improvement that was not obvious to those skilled in the art is invention.

The consideration of the patent by the Circuit Court of Appeals continues and concludes (R. 63, omitting the footnote):

> We are in accord with the learned district judge in his view that the use of such material for analogous purposes was extensive and well-known.

In fact petitioners elicited, on direct examination of the witness Siebs, that all of the components of the electrical heating element of the patent in suit were known and in use at least as early as 1910. (R. 160, 161.)

The deficiencies of the mica heaters were recognized, not only as early as 1910, but prior to 1910. (R. 160.) Anything additional that may be disclosed in the Luftfahrzeugbau patent, was known in the Minchew patent 563,780, in 1896. (R. 239-241, part of Exhibit D-41, offered at R. 90.)

In the period 1910 through 1922, the art was extremely active, in an endeavor to find a satisfactory electric heating element. (R. 160-161.) At least 750 United States patents on electrical heating devices issued on applications filed during that period, including 52 to General Electric Company, 37 to Cutler-Hammer Company, 38 to Westinghouse Company, and 221 to other manufacturers that were active in the art. (R. 175-176.)

Yet it remained for Wiegand to solve the problem, in 1923, and then the solution was rejected as incredible.

The plan was to market the elements through companies already in the market, and first the Wiegand Com-

pany approached the Cutler-Hammer Company, who were making and selling mica heaters. Mr. Edwin Lightfoot, the head of the Heating Engineering Department, called on Mr. Wiegand, and the matter was discussed. Mr. Lightfoot said to Mr. Wiegand "Do you mean to say that you can make a strip of that stuff there two feet long or more and just about a quarter of an inch thick, that would be light enough for us to sell? Why, it would break, it would break in two like a piece of porcelain." (R. 171-172.)

The Cutler-Hammer Company rejected the improvement as incredible, and substantially the same experience was repeated with the Westinghouse Company, and then the Wiegand Company decided to market the units directly. Then the same incredibility was encountered in the trade. (R. 172-173.)

The experience at Western Electric Company is related by Mr. Siebs. Mr. Siebs joined Western Electric Company in 1923, and at that time formed the heating and electrical laboratory, for the purpose of endeavoring to better the conditions of the electric heating elements with which Western Electric Company at that time was having great trouble. (R. 156.)

Nevertheless, Mr. Siebs and his associates were not interested in trying the Wiegand units. As Mr. Siebs expresses it (R. 158):

> I was unable to visualize the possibility of a thin sheath, itself having relatively no mechanical strength whatsoever, and of a contour which did not retain the insulating material under compression with the same ease as a round section would, that a heater made and filled with a refractory insulation, subject as these heaters were to bending, twisting, and general distortion under heating and cooling, could possibly retain the granular refractory insulation in anything like useful form for any length of time.

It was the opinion that granular refractory insulation was not feasible in a thin flat sheet metal sheath, or as Mr. Siebs expresses it (R. 158-159):

> At that time our only experience with granular refractory insulation was with the sheathed wire and tubular heaters. These heaters were made with circular sheaths. The insulation was compressed tremendously by swaging the outside sheath down to a smaller section, and even with that relatively ideal mechanical contour and method of retaining the compression that was given by the swaging, we found that they were extremely fragile to use. We received these tubular heaters from the manufacturers in a straight form, they came in straight lengths with terminals on either end, and in order to use them we invariably had to bend them in some form or other to adapt them to the particular use that we wanted to make, and the number that we destroyed in our effort to bend them was so high that we very soon refused to accept any of these heaters in their straight form, or else if we did, we returned them to the manufacturers to have them bent, so that they could take the responsibility of spoiling the heater rather than ourselves. That, of course, led us to be more than skeptical that a heater of the type described by Mr. Tourtelot and Mr. Calhoun could withstand the natural abuse of bending and twisting and warping that these strip heaters are subjected to.

However, the Wiegand Company succeeded in furnishing units for tests, and a Wiegand unit was tested against Cutler-Hammer mica heaters then standard with Western Electric. (R. 159.) The units were of the same rating, but the mica heater at 115 volts and the Wiegand unit at 110 volts. (Exhibit W-81, R. 210-212, offered at R. 159.) Thereby the load or overload on the Wiegand unit at all times was somewhat greater than on the mica heaters.

The units were operated at from 110 to 180 volts, a total of 22 hours, and the mica heater failed. A new mica heater was substituted, against the same Wiegand unit, and the two were operated at 180 volts for 24 hours, and the second mica heater failed. Then the test was continued on the Wiegand unit alone, 137 hours at 268% rating, 211 hours at 298% rating, and 240 hours at 400% rating. (Exhibit W-81, R. 210-212, offered at R. 159.) Western Electric Company adopted the Wiegand units as standard, replacing the mica heaters. (R. 159.)

The witness Magerstadt related the similar experience at Railway Utility Company, as a result of which Railway Utility adopted the Wiegand elements, replacing Westinghouse mica heaters (R. 141-144), and the witness Ledig the similar experience at Majestic Electric Company, as a result of which Majestic adopted the Wiegand elements, and closed their own department in which they had made mica heaters. (R. 145-148.)

These three experiences are typical. (R. 173, 186.)

Certainly the so-called substitution was not obvious to those skilled in the art, and as stated by Judge Learned Hand in *Hookless Fastener Co. v. G. E. Prentice Mfg. Co.*, 68 F. (2d) 940 at 941, the Court is to "look rather to the history of the art than to our own divinations of what was easy and apparent."

Clearly the decision of the Circuit Court of Appeals is in direct conflict with the decision of this Court in *Expanded Metal Company v. Bradford,* 214 U. S. 366 at 381, 29 S. Ct. 652 at 656:

> It may be safely said that if those skilled in the mechanical arts are working in a given field and have failed after repeated efforts to discover a certain new and useful improvement, that he who first makes the discovery has done more than make the obvious improvement which would suggest itself to

a mechanic skilled in the art, and is entitled to protection as an inventor.

Citing *Webster Loom Company v. Elias S. Higgins et al.*, 105 U. S. 580 at 591, 26 L. Ed. 1177 at 1181.

CONCLUSION

It seems that the conflict should be resolved. If the claims are invalid, the invalidity should be established to the benefit of the industry generally, and if the claims are valid, they should be recognized also against respondents.

It seems that the claims are valid, and that the holding of invalidity, and the concepts on which the holding of invalidity is predicated, are in error, and should be corrected.

Because of the general recognition of the patent, any basis for another suit is not likely to occur. *Exhibit Supply Co. v. Ace Patents Corporation,* and two other cases, numbers 154-156, decided February 2, 1942, 62 S. Ct. 513.

Petitioners pray that their petition be allowed.

Respectfully,

HADLEY F. FREEMAN,

Counsel for Petitioners.

(20)

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HAROLD E. TRENT COMPANY and HAROLD E. TRENT,
Respondents.

Brief for Respondents in Opposition to Petition for Writ of Certiorari.

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HAROLD E. TRENT COMPANY AND HAROLD E. TRENT,

Respondents.

BRIEF FOR RESPONDENTS IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

FOREWORD.

This is an ordinary patent case. There is no conflict of decisions between courts of appeal of different circuits and no other reasons such as those set forth in Rule 38, Sect. 5, for granting of the writ of certiorari.

The petition is directed solely to the issue of validity of claims 1, 3, 5, 8, 9 and 12 of Wiegand Patent No. 1,614,330 after disclaimer. The patent was held invalid before disclaimer by the District Court because of anticipation and for want of invention in view of the prior patented art (R-31). On rehearing, after disclaimer, the District Court again held the patent invalid as anticipated and for want of invention over the prior art (R-52).

The Circuit Court of Appeals affirmed (R-64-68) and denied rehearing (R-68).

Neither the District Court nor the Circuit Court of Appeals passed on the question of infringement of the patent after the disclaimers were entered therein.

ARGUMENT.

I.

There Is No Conflict of Opinion.

(a) The Circuit Court of Appeals for the Sixth Circuit, in the Wiegand v. Cutler-Hammer case, did not pass on the question of validity of the patent.

The petition itself admits this, stating that the decree (Exhibit D-68) was "affirmed on appeal, but without passing on the holding of validity" (petition, page 7 as corrected). In addition see the opinion of the Sixth Circuit Court of Appeals (R-228).

Thus it is plain from the petition and the opinion that there is no conflict between decisions of Courts of Appeal.

Even as to the opinion of the District Court in the Cutler-Hammer case, there is no real basis for saying that the patent was held valid, for the basis of the decision was non-infringement.

As Judge Kirkpatrick stated with respect to that opinion: "the question of the validity of the patent as thus narrowed was not directly in issue" (R-28), and this is fully borne out by a reading of the opinion in question (R-221-223).

The *decree* of the District Court in the Cutler-Hammer case purported to adjudicate the validity of the patent (R-225). But since the cause was disposed of on the ground of non-infringement this purported adjudication was immaterial to the disposition of the cause and should not have been embodied in the decree. *Electrical Fittings Corporation v. Thomas and Betts Company*, 307 U. S. 241-2 (decided after date of entry of the Cutler-Hammer decree).

(b) Even if it be assumed that the Courts of the Sixth Circuit had ruled on validity of the patent there is still no conflict of opinion. The patent finally held invalid by the Courts of the Third Circuit was not the same patent as that considered in the Sixth Circuit for it had been extensively modified by disclaimers.

In *Altoona Publix Theatres v. American Tri-Ergon Corporation,* 294 U. S. 477, 492, this Court stated:

> "The disclaimer is a representation, as open as the patent itself, on which the public is entitled to rely, that the original claim is one which the patentee does not, in the language of the statute, 'choose to claim or hold by virtue of the patent'. Upon the filing of the disclaimers, the original claims were withdrawn from the protection of the patent laws, and the public was entitled to manufacture and use the device originally claimed as freely as though it had been abandoned."

Thus, as to the four claims in which disclaimers were entered there can be no question that the original claims, before disclaimer, are no longer in existence. They are "withdrawn from the protection of the patent law", and the patent as considered in the Third Circuit was to that extent not the same as the patent considered in the Sixth Circuit.

Claims 8 and 9, in which no disclaimers were entered, are likewise affected, for the disclaimers affect the whole patent. The disclaimers are a confession that the patentee in the claims in which they were entered claimed "more than that of which he was the original or first inventor or discoverer" (*Maytag v. Hurley Machine Co.,* 307 U. S. 243) and this "confession" applies not only to the claims in which the disclaimers were entered but to the whole patent.

Claims 8 and 9 cannot escape the consequences of the confession involved in the disclaimers to the other claims. They are directed to the same article as the four claims in which disclaimers were entered and embody the substance of what was set forth in claims 1, 3 and 5 before disclaimer. Claims 8 and 9 elaborate in particulars but the fundamental combination of elements of original claims 1, 3 and 5 is the fundamental combination of claims 8 and 9. The disclaimers to claims 1, 3 and 5 necessarily, therefore, must be given effect in construing claims 8 and 9, and when thus given effect the claims are no longer the same.

(Note—It is our position that the whole patent is invalid under the ruling of *Maytag v. Hurley,* supra, but we cite the case here only on the point that the disclaimer involved a confession that the patentee claimed more than he invented.)

The same conclusion must follow from *Altoona Publix Theatres v. American Tri-Ergon Corporation,* supra, for if subject matter of the original claims is withdrawn from the protection of the patent law and the public is entitled to manufacture and use the device originally claimed, then the scope and interpretation of other claims must necessarily be affected, and this especially when, as here, the substance of the two claims in question consists of what was disclaimed in others.

(c) Finally, there is no conflict of opinion because the patents most relied on in the Third Circuit (Muller and Luftfahrzeugbau) were not, as Judge Kirkpatrick pointed out—R-28), before the Court in the Cutler-Hammer case in the Sixth Circuit. Judge Kirkpatrick, in both opinions, held the claims to be anticipated by these patents (R-28 and 52) and the Court of Appeals affirmed (R. 68).

The Cutler-Hammer case was, therefore, decided on evidence which differed in essentials from that on which the case was decided in the Third Circuit, and in such circumstances there could be no conflict.

* * * * * *

Petitioners also contend "that the holding of invalidity is in conflict with the prevailing recognition of the invention". (Petition p. 7.) This argument is based on supposed commercial success and recognition in one form or another.

Evidence to establish commercial success and recognition is present in patent cases almost without exception. But such evidence is without significance on the question of novelty, *Toledo Pressed Steel Co. v. Standard Parts,* 307 U. S. 350, 356, 357, and the patent here involved was held to be anticipated, i. e., lacking in novelty.

Even on the question of invention, commercial success and recognition are given weight only when invention is in doubt, *Altoona Publix Theatres v. American Tri-Ergon Corp.,* 294 U. S. 477, 488, and cases there cited, and may not be used to create a doubt as well as to resolve it. *Republic Rubber Co. v. G. & J. Tire Co.,* 212 Fed. 170, 172 (C. C. A. 7).

Obviously, therefore, commercial success and recognition should not be dignified to the extent that they counterbalance the weight of a well considered judgment of a competent court to create a "conflict", and this especially where the patent was held to be anticipated as well as wanting in invention.

If testimony as to commercial success and recognition serve as the basis of creating a "conflict" justifying the

grant of a writ of certiorari, most of the cases where the patent is held invalid would come to this Court.

II.

Petitioners contend (Petition pp. 8-9) that the holding of invalidity is predicated on an interpretation of the invention, different from the invention as defined by the claims.

This is based on the assumption that no consideration was given to the claims of the patent for the reason that the Court of Appeals made a brief general statement as to what was involved in the invention * (R-62) and did not quote the claims in full.

Cases are cited to the point that the claims must be turned to in seeking to determine what the invention is. That of course is elementary and to say that the Court did not do so, solely because the claims were not quoted, is nothing more than unwarranted speculation implying that the Court failed in its duty.

III.

Petitioners' third argument (Petition pp. 9-13) boils down to a contention that foreign patents to Muller and Luftfahrzeugbau do not disclose what the lower Courts found them to disclose and that they are, therefore, not adequate, under the law to support a judgment of invalidity of the patent in suit on the grounds of anticipation or want of invention.

---

* It is interesting to note that petitioners' witness Calhoun in answer to a question as to what the Wiegand units in general comprised, answered "a resistor wire, embedded in a refractory, and sheathed in a metal sheath", (R-71, Q. 16 and Answer)—language almost identical with that used by the Court in giving the brief general description of the invention.

The District Court in its first opinion, on the very basis of "plaintiffs' testimony" (R-28) and a careful study of the disclosures of the foreign patents (R-27), found that they disclose what petitioners deny they do and that they anticipate.

In the second opinion, after rehearing in which plaintiff Wiegand elaborated on his testimony as to these foreign patents, the District Court stated: "After full consideration, I reaffirm my conclusion that the '330 patent is invalid as anticipated, and state an additional conclusion that, if not fully anticipated, it is invalid for want of invention over the prior art." (R-52.)

In both opinions ample support in the record for the findings is referred to.

The Court of Appeals did not disturb these findings.

Petitioners' whole argument, therefore, is based, not on any conflict of the decision with applicable law, but on contention of inadequacy of the patents because of a quarrel with the lower Courts as to what the patents disclose.

This is a question of fact and this Court does not grant writs of certiorari "merely to review the evidence or inferences drawn from it." Nor to review questions of anticipation and invention unless there is a conflict between decisions of Circuit Courts of Appeal. *General Talking Pictures Corp. v. Western Electric Company,* 304 U. S. 175, 178.

(As pointed out above (pp. 4, 5) there is no such conflict here for the foreign patents in question were not before the Court in the Sixth Circuit.)

Another complete answer to the whole argument lies in the fact that the patent in suit was held invalid for want

of invention over the prior art generally (R-52) and this prior art includes many United States patents, e. g. Hadaway, No. 1,150,426 (referred to by the District Court R-26), and Lightfoot, No. 1,403,331, which are just as effective as the foreign patents on this score.

IV.

Petitioners' fourth argument (Petition pp. 13 to 17) is to the point that the alleged improvement was not obvious to those skilled in the art and therefore involved invention.

The first answer to this is that the District Court in both opinions, in addition to finding no invention, held the patent invalid as *anticipated* (R-28 and 31, and R-52) and this was not disturbed on appeal. In order to anticipate or to negative novelty—

> "it is necessary that all of the elements of the invention or their equivalents be found in one single description or structure where they do substantially the same work in substantially the same way."
>
> *Walker on Patents*—Deller Edition, Vol. I, page 255, and cases there cited.

and petitioners completely ignore the finding of the Court that there was anticipation.

However, even on the question of *invention*, petitioners again ask this Court to review the case not because of any conflict with established law but solely on the ground of the application of the law to the facts of this case.

There are many cases to the effect that the substitution of one well known material for another does not involve invention.

Terhune v. Phillips, 99 U. S. 592;
Brown v. District of Columbia, 130 U. S. 87;
Florsheim v. Schilling, 137 U. S. 64;
American Fruit Growers v. Brogdex, 283 U. S. 1, 14.

and even if it be assumed that Muller and Luftfahrzeugbau disclosed nothing more than mica the only question is whether the substitution of a well known electrical insulating material in place of the mica involved invention. In finding that it did not, the lower Courts merely applied a well established rule of law to the facts of this case and this does not provide a reason for the granting of a writ of certiorari.

That the precise material used by defendant (aluminum oxide), was well known for the very purpose in this heater art as early as 1910, is explained by petitioner Wiegand himself in a letter, Exhibit D-67 (R. 224a and 224b), written in 1922, in which he states:

> "The only patent which the Dover Company has is the one attempting to cover the use of aluminum oxide granules with a ceramic bond for heater insulation purposes.
>
> "This is none other than 'Alundum Cement,' which was originated and sold on the market by the Norton Company of Worcester, Mass., as early as 1910.
>
> "Therefore the material which they intend to cover was not only the work of other people, but their patent is invalid, because of the length of time this material has been known in the heater art.
>
> "The patent you refer to was issued in 1920 I believe and I knew this material and made elements of it myself as early as 1911."

CONCLUSION.

There is no conflict of decision between Circuit Courts of Appeal.

The other grounds set forth in the petition raise only questions of the application of the law to the particular facts of this case and are of interest only to the parties. As Mr. Chief Justice Hughes pointed out in his remarks at the American Law Institute meeting, as reported in the June, 1934, issue of the American Bar Association Journal:

> "That review (by writ of certiorari) is in the interest of the law, not in the interest of particular parties."

The petition should be denied.

Respectfully submitted,

HARVEY L. LECHNER,
EDWARD H. DAVIS,
For Respondents.

March, 1942.

(21)

APR 3 1942

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1941.

NO. 991.

EDWIN L. WIEGAND COMPANY AND
EDWIN L. WIEGAND,

Petitioners,

vs.

HAROLD E. TRENT COMPANY AND
HAROLD E. TRENT,

Respondents.

REPLY BRIEF FOR PETITIONERS ON PETITION FOR WRIT OF CERTIORARI

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FOREWORD

In petitioners' view, this is not an ordinary patent case, and there is ample reason for granting the writ.

Further, the Circuit Court of Appeals affirmed only for want of invention. (R. 62-63.) Also, the entire proceedings in the District Court, subsequent to the filing of the disclaimer, were on the basis that the disclaimer made no change in regard to infringement of the claims if valid.

I (a)

This section of the Brief for Respondents is predicated on the facts of the Cutler-Hammer suit, that the District Court held the claims valid, but not infringed by the Cutler-Hammer elements, and that the Circuit Court of Appeals affirmed on non-infringement, without passing on the holding of validity.

Respondents agree that these facts are set forth in the Petition and Brief, and argue that therefore it is plain that

there is no conflict between decisions of Courts of Appeals. Apparently respondents refer to the first situation of paragraph (b) of section 5 of Rule 38:

> Where a circuit court of appeals has rendered a decision in conflict with the decision of another circuit court of appeals on the same matter; * * *.

Of course, the Rule is explicit that the situations enumerated are neither controlling nor fully measure the Court's discretion, but it seems that the present case is well within the spirit even of the particular situation, under the circumstance that petitioners took every step toward securing a decision on the holding of validity, and that because of the general recognition of the patent throughout the industry, any basis for another suit is not likely to occur. (*Exhibit Supply Co. v. Ace Patents Corporation* and two other cases, numbers 154-156, decided February 2, 1942.)

Against that conclusion respondents propose that the holding of validity in the *Cutler-Hammer* suit be disregarded entirely.

Respondents argue that there is no real basis for saying that the patent was held valid, for the basis of the decision was non-infringement, and quote Judge Kirkpatrick in support. However, it is manifest from the report of the Special Master and the decision of the District Court, that the validity of the patent was very much in issue. (Exhibit D-66, not printed, and Exhibit D-65, R. 221-223, offered at R. 140.) Consequently it was quite in order for the Master and the District Court to find as to validity. (*Interstate Circuit, Inc., et al. v. United States*, 304 U. S. 55.) Further, obviously any finding of validity did not cease to be a judicial determination merely because ultimately it was not necessary to the final disposition of the suit.

Finally respondents propose to dispose of the holding of validity in the decree of the District Court on the rule

of *Electrical Fittings Corporation et al. v. Thomas & Betts Co. et al.*, 307 U. S. 241.

No doubt Cutler-Hammer could have required that the holding of validity be omitted from the decree. On the contrary, Cutler-Hammer approved the decree. (R. 225-226.) Respondents secured leave to and offered the decree. (A-93-94.) And thereupon it seems that the decree is sufficient evidence that the District Court adjudged the patent valid.

I (b)

In this section respondents argue that there is no conflict because "The patent finally held invalid by the Courts of the Third Circuit was not the same patent as that considered by the Sixth Circuit for it has been extensively modified by disclaimers."

The disclaimer limited claims 1, 3, 5, and 12. (Exhibit P-6, R. 201-206, offered at R. 140.) Therefore the disclaimer did not avoid the conflict, unless it be assumed that the "Courts of the Third Circuit," although they held the narrowed claims invalid, would have held the original claims valid.

On the contrary, the District Court held specifically, that the disclaimers "do not change the essence of the patent." (R. 52.) Further, there has been no disclaimer as to claims 8 and 9.

I (c)

In this section respondents argue that there is no conflict because the Muller and Luftfahrzeugbau patents were not before the Court in the Cutler-Hammer case, and that the Cutler-Hammer case therefore was decided on evidence different from that on which the present case was decided.

The record in this suit contains four items from the Cutler-Hammer suit, namely: Exhibit D-66, the report of

the Special Master, not printed, offered at R. 140; Exhibit D-65, the decision of the District Court, R. 221-223, offered at R. 140; Exhibit D-68, the decree of the District Court, R. 225-226, offered at A-93-94; and Exhibit D-69, the opinion of the Circuit Court of Appeals, R. 226-232, offered at A-93-94.

The Muller and Luftfahrzeugbau patents are not identified in these four items. However, many of the patents offered by respondents are not identified in any of the opinions in the present suit. The record in this suit does not show either that the Muller and Luftfahrzeugbau patents were or were not before the Court in the Cutler-Hammer suit.

Petitioners offer to stipulate the facts.

On the other hand, these four items show that there were before the Court in the Cutler-Hammer suit patents showing everything disclosed by the Muller and Luftfahrzeugbau patents, so that in any event the holding of validity in the Cutler-Hammer suit was not the result of any absence of any substance on which the present suit was decided. In fact respondents argue at page 8, that the prior art includes many United States patents which are just as effective.

I (x)

Further in section I (c) respondents contend that the general recognition of the patent in the industry is without significance. However, respondents base this contention on an assumption that the Circuit Court of Appeals held the patent anticipated. On the contrary, the opinion of the Circuit Court of Appeals recognizes explicitly that there was "escape from anticipation" in the "substitution" of material. (R. 62-63.)

Therefore the entire evidence, of the existence of the problem, the efforts at solution, the failure of solution, even the rejection of the solution, and then the success and

recognition, all is material to show that the so-called substitution was beyond skill in the art, and involved invention.

II

Respondents state that petitioners' second ground is based on the assumption that no consideration was given to the claims for the reason that the Court did not quote the claims in full. Respondents add that to say that the Court did not consider the claims solely because the claims were not quoted, is nothing more than unwarranted speculation implying that the Court failed in its duty.

Yet there is nothing in the Petition and Brief even suggesting that the Court should have quoted the claims, or any of the claims, and obviously whether or not the Court quoted the claims, or any of the claims, was entirely immaterial, and respondents' argument fails entirely.

In the footnote respondents recite that petitioners' witness Calhoun stated that in general the Wiegand units comprise "a resistor wire, embedded in a refractory, and sheathed in a metal sheath." Respondents state that this language is almost identical with that used by the Court in describing the invention. It is not apparent how a definition of the invention would be correct because it corresponded to a statement by a lay witness of what the units comprise. On the other hand, the comparison emphasizes the discrepancy of the interpretation. The Court did not limit the invention even to sheathed elements. (R. 62.)

III

Respondents argue that petitioners' third ground "boils down to a contention that foreign patents to Muller and Luftfahrzeugbau do not disclose what the lower Courts found them to disclose," and that "This is a question of fact," to review which this Court will not grant writ of certiorari.

However, there is no dispute as to fact. For example, there is no question but that the Muller patents are silent as to whether or not the insulating material fills the space between the resistor and the sheath, and that the Luftfahrzeugbau patent is silent as to whether any part of the insulating material is integrated into formation positively spacing the resistor from the sheath. The only question is the question of law, whether the Court is entitled to assume one way, and then defeat the patent on the assumption.

The substance of the parenthetical paragraph on page 7 has been answered under section I (c).

In regard to the last paragraph, petitioners believe that a fair reading, particularly of the original opinion of the District Court, requires the conclusion that the District Court based its holding of invalidity on the Muller and Luftfahrzeugbau patents, whether for anticipation or for want of invention. Certainly any doubt would have been resolved had the District Court made findings and conclusions, as petitioners requested (A-94):

> (E) Plaintiffs having then asked leave to present proposed findings of fact and conclusions of law, thereupon plaintiffs' said request was and hereby is denied, and it was and hereby is ordered that the statements of fact and the statements of law in the opinions filed September 14, 1938, and September 27, 1939, shall constitute respectively the findings of facts and the conclusions of law for the purposes of Rule 52 of the Rules of Civil Procedure.

However, certainly the Circuit Court of Appeals held the claims invalid only on the single ground of want of invention over the Muller and Luftfahrzeugbau patents. (R. 62-63.)

IV

Respondents' contention that the Circuit Court of Appeals held the patent invalid as anticipated has been answered under section I (x).

Otherwise respondents contend that "petitioners ask this Court to review the case not because of any conflict with established law but solely on the ground of the application of the law to the facts of this case."

In other words, there is no question as to the facts, and it is entirely a question of law, as to what constitutes patentable invention, and the Circuit Court of Appeals has decided a federal question squarely in conflict with applicable decisions of this Court. (Rule 38, section 5, paragraph 6.)

CONCLUSION

Petitioners pray that the writ of certiorari be granted.

Respectfully,

HADLEY F. FREEMAN,

Counsel for Petitioners.